

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Kobeh, Gerardo

Serial No.: 10/673,431

Filed: September 30, 2003

For: GRANTS MANAGEMENT SYSTEM

Examiner: KAZIMI, HANI M.

Art Unit: 3691

Confirmation No.: 2620

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REPLY BRIEF UNDER 37 C.F.R. 41.41**

Dear Sir:

In response to the Examiner's Answer mailed on February 20, 2009, for the above-identified application, submitted herewith include:

- **STATUS OF CLAIMS**, which begins on page 2;
- **GROUND OF REJECTION TO BE REVIEWED ON APPEAL** which begins on page 2; and
- **ARGUMENT** which begins on page 2.

## **I. STATUS OF CLAIMS**

Pending claims 1-27 stand finally rejected and are the subject of this appeal.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Claims 1-10, 13-18, 20, and 22-27 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. Pub. No. 2002/0120538 to Carrie et al. ("Carrie"), in view of U.S. Patent App. Pub. No. 2005/0192826 ("Kanefsky").

B. Claims 11, 19 and 21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie in view of Kanefsky, and in further view of Official Notice.

C. Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie and Kanefsky, and in further view of U.S. Patent No. 7,111,010 to Chen et al. ("Chen").

## **III. ARGUMENT**

### **A. The Rejections of Claims 1-10, 13-18, 20, and 22-27 Under 35 U.S.C. § 103(a) Must Be Reversed**

#### **1. The Kanefsky Reference Is Not a Proper Prior Reference**

Claims 1-10, 13-18, 20, and 22-27 were rejected under 35 U.S.C. § 103(a) as unpatentable over Carrie, in view of Kanefsky, U.S. Patent Application Publication No. 2005/0192826, filed August 20, 2004 ("the Kanefsky 2004 filing"). However, the Kanefsky 2004 filing is not a proper prior art reference because the Kanefsky 2004 filing (which was filed after September 30, 2003, the filing date of the present application) cannot benefit from the priority date of the provisional application filed August 21, 2003 ("Kanefsky's Provisional") under M.P.E.P. 2136.03 III.

The Appeal Brief filed December 29, 2008, sets forth reasons why the Kanefsky 2004 filing is not a proper prior art reference under M.P.E.P. 2136.03 III. Simply stated, up until the Examiner's Answer, the Examiner did not provide any support to the assertion that Kanefsky's Provisional properly supports the subject matter on which the Examiner relied to reject claims of the present application. Only in the Examiner's Answer mailed February 20, 2009 did the Examiner provide additional grounds as to which portions of Kanefsky's Provisional support the relied on subject matter of the Kanefsky 2004 filing. Even so, the newly alleged portions of

Kanefsky's Provisional still do not support the priority date of the Kanefsky 2004 filing under M.P.E.P. 2136.03 III. The additional grounds raised in the Examiner's Answer are addressed as follows.

As a preliminary matter, the Examiner has again misunderstood and misconstrued the M.P.E.P. The Examiner asserted that M.P.E.P. 706 and M.P.E.P. 2136.03 III go hand-in-hand and therefore, that to benefit from the priority date, Kanefsky's Provisional must "provide adequate support and enablement for the claimed subject matter" of the Kanefsky 2004 filing (the Examiner's Answer, p. 24). In essence, the Examiner deems the scope of M.P.E.P. 2136.03 III as identical to M.P.E.P. 706. This is simply wrong. M.P.E.P. 2136.03 III requires Kanefsky's Provisional supports the Kanefsky 2004 filing as to the subject matter relied upon to reject claims of the present application – which is wholly different from the subject matter claimed by the Kanefsky 2004 filing.

Claim 1 recites, in part,

a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors

With respect to this feature, the Examiner in the Final Office Action conclusorily asserted that FIG. 1 and paragraph 21 of the Kanefsky 2004 filing disclose, teach, and suggest this feature. Further, in the Examiner's Answer, the Examiner conclusorily asserted that pages 2 and 4, and figures on pages 67 and 68 of Kanefsky's Provisional support the relied on FIG. 1 and paragraph 21 of the Kanefsky 2004 filing in compliance with 35 U.S.C. § 112 ¶ 1.

Kanefsky's Provisional's pages 2, 14, 67 and 68 do not provide 112 ¶ 1 support for the relied on FIG. 1 and paragraph 21 of the Kanefsky 2004 filing. As explained in the Appeal Brief, the background section contained in Kanefsky's Provisional's page 2 makes it clear that it is merely concerned with a grant reporting system for a Grantor. Consistent with page 2, Kanefsky's Provisional's page 14 is merely concerned with accessing the reporting system. The figure on page 67 merely shows a grantee is connected to a grantor via a server for the grant reporting purpose. The figure on page 68 merely shows an alleged Orion Grant Management System for a grantor agency. As such, Kanefsky's Provisional's pages 2, 14, 67 and 68 do not provide 112 ¶ 1 support for the relied on FIG. 1 and paragraph 21 of the Kanefsky 2004 filing as asserted by Examiner in prior Office Actions. More importantly, Kanefsky's Provisional's

pages 2, 14, 67 and 68 by themselves do not disclose or suggest a computer-implemented grants management method **for a recipient** received from a plurality of grant sponsors.

Claim 1 further recites, in part,

determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid

With respect to this feature, the Examiner in the Final Office Action conclusorily asserted that paragraph 33 of the Kanefsky 2004 filing discloses, teaches, and suggests this feature. Further, in the Examiner's Answer, the Examiner conclusorily asserted that pages 3, 11 and 27 of Kanefsky's Provisional support the relied on paragraph 33 of the Kanefsky 2004 filing in compliance with 35 U.S.C. § 112 ¶ 1.

To arrive at this conclusion, the Examiner first construes this claimed feature as simply converting "imported data to previously defined files or folders for respective grants" – essentially just copying files between file folders. However, this construction of the claimed feature is inconsistent with the specification of the present application. The M.P.E.P. makes it clear that a claim feature must be "given their broadest reasonable interpretation **consistent with the specification.**" M.P.E.P. 2111 (emphasis added). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *Id.* and *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). The Specification of the present application (page 5, paragraph 17) makes it plain that the claimed feature entails making decisions of whether the converted transactional data under different grants are valid. Nowhere does the Specification teach or suggest that the claimed feature can be construed as simply converting "imported data to previously defined files or folders for respective grants" without determining if the converted data maps to a valid classification of grants. Therefore, the Examiner improperly construed the claimed feature because the construction is inconsistent with the specification of the present application.

Further, pages 3, 11 and 27 in Kanefsky's Provisional do not provide 112 ¶ 1 support for the relied on paragraph 33 of the Kanefsky 2004 filing. As explained in the Appeal Brief, the paragraph 33 describes the corresponding FIG. 4 in the Kanefsky 2004 filing, which is reproduced below for convenience. The FIG. 4 shows multiple components interconnected together. Each component has specific functions. In contrast, the alleged pages 3, 11, and 27

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## **2. The Combination of Carrie and Kanefsky's Provisional Does Not Render Claims 1-10, 13-18, 20, and 22-27 Unpatentable**

The Appeal Brief sets forth reasons why the combination does not disclose these claims. Even though only the Kanefsky's Provisional has a filing date prior to the present application, the Examiner never directly addresses how Kanefsky's Provisional discloses claimed features in any of the prior Office Actions.

With respect to claim 1 to the extent of newly asserted grounds in the Examiner's Answer, as discussed above, any reading of Kanefsky's Provisional's pages 2, 14, 67, and 68 does not disclose or suggest a computer-implemented grants management method **for a recipient** received from a plurality of grant sponsors.

Moreover, any reading of Kanefsky's Provisional's pages 3, 11, and 27 does not disclose, or even suggest, the claimed feature of determining if the converted data maps to a classification defined under grants to be valid recited in claim 1. In the Examiner's Answer, the Examiner implies pages 3, 11, and 27 of Kanefsky's Provisional as assertedly disclosing this claimed feature. However, these pages (as summarized above) simply does not disclose, or even suggest, the claimed feature. In particular, these alleged pages do not disclose a classification defined under one grant or making a determination of whether data converted from a transaction system is valid in the classification. Therefore, Kanefsky's Provisional does not render claim 1 or any of its dependent claims 2-5 obvious.

Independent claims 6, 10, 13, 20, and 23, and their respective dependent claims include features substantially similar to claim 1 and therefore, are allowable for substantially the same reasons as claim 1. A reversal of rejections of claims 1-10, 13-18, 20, and 22-27 is respectfully requested.

## **3. The Examiner Did Not Consider All Elements Recited in Claims 1-5**

For reasons set forth in the Appeal Brief, the Examiner simply failed to consider all elements recited in claim 1, in particular, the element of:

responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants

in prior Office Actions. M.P.E.P. 2143.03 requires the Examiner to consider all claim limitations. Further, the cited prior art references must teach or suggest **all of the claim limitations**. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

In the Examiner's Answer, the Examiner relies on the language<sup>1</sup> of *In re Keller*, 642 F.2d 413 as the legal basis of the Examiner's failure to consider the claimed feature. However, the Examiner has again misapplied the law. The cited language of *In re Keller* is directed to arguments against reasons for combining prior references. See M.P.E.P. 2145 III. It does not give the Examiner a free pass to reject claimed features without basis. For this application, Applicants simply argue that the Examiner must consider (or clearly articulate reasons against) the above claimed feature under M.P.E.P. 2145 III and *in re Fine*, -- which the Examiner failed and still refuses to do.

In the Examiner's Answer, the Examiner further conclusorily states in essence that even though the Examiner failed to consider the above claimed feature, the feature is obvious to one of ordinary skill in the art in view of other features. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and M.P.E.P. 2142. Without any prior reference or articulated reasoning, the Examiner committed impermissible hindsight in rejecting claim 1. Therefore, a reversal of the rejection of claim 1 and its dependent claims 2-5 is respectfully requested.

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<sup>1</sup> The Examiner cites: the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Accordingly, for the foregoing reasons, the rejections of claims 1-5 under 35 U.S.C. § 103(a) must be withdrawn.

**B. The Rejection of Claims 11, 19, and 21 under 35 U.S.C. 103(a) Must Be Reversed**

Claims 11, 19, and 21 depend from independent claims 10, 13, and 20, respectively and therefore, are allowable for the same reasons as claims 10, 13, and 20 since the alleged Official Notice does not cure or allege to cure the critical deficiencies of the combination of Carrie and Kanefsky.

Therefore, reversal of rejections to claims 11, 19, and 21 is respectfully requested.

**C. The Rejection of Claims 12 under 35 U.S.C. 103(a) Must Be Reversed**

Claim 12 depends from independent claim 10 and therefore, is allowable for the same reasons as claim 10 since the alleged tertiary Chen reference does not cure or allege to cure the critical deficiencies of the combination of Carrie and Kanefsky.

Therefore, reversal of rejection to claim 12 is respectfully requested.

**IV. CONCLUSION**

Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's decision rejecting claims 1-27 and direct the Examiner to pass the case to issue. These claims are statutory and allowable over the cited art.

Respectfully submitted,

Date: April 17, 2009

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